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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,822	04/25/2000	Timothy A. Barton	2799CIP	9903

7590 02/11/2004

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EXAMINER

NORMAN, MARC E

ART UNIT	PAPER NUMBER
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3744

DATE MAILED: 02/11/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,822

Applicant(s)

BARTON, TIMOTHY A.

Examiner

Marc E. Norman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 14-20 been renumbered 15-21.

Election/Restrictions

Newly submitted claims 15-21 (as renumbered above) are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Original claims 1-3 and 6 are directed to programs or software for sequentially displaying a plurality of accessorial services and requiring the user to address each of said accessorial services offered and to accept or decline said accessorial services.

Claims 15-18 are directed to permitting a user to review status of shipments made by the user.

Claims 19-21 are directed to presenting an internet page to allow the user to schedule a ready date and time of shipment.

The inventions of claims 15-21 are usable separately from the inventions of claims 1-3 and 6 (i.e., in a system that does not comprise programs or software for sequentially displaying a plurality of accessorial services and requiring the user to address each of said accessorial services

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offered and to accept or decline said accessorial services). Likewise, the inventions of claims 1-3 and 6 are usable separately from the inventions of claims 15-21 (i.e., in a system that does not comprise permitting a user to review status of shipments made by the user or presenting an internet page to allow the user to schedule a ready date and time of shipment).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 15-21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

Applicant's arguments filed 5 January 2004 have been fully considered but they are not persuasive.

Applicant raised several arguments regarding claim 1, each of which is responded to in turn below.

Reducing Errors in Ordering

The preamble of claim 1 limits the claimed invention to, among other things, a computer based system for reducing user errors in ordering freight services. By contrast, the alleged prior art Printout shows a quoting service that does not allow the user to order freight services. Claim 1 is limited to a system for reducing errors in ordering actual freight services. As acknowledged during the November 6, 2001, interview, the preamble to claim 1 constitutes a claim limitation. There can be no anticipation since the Printout fails to disclose at least one claimed invention. (paper # 14, page 1 of Remarks)

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The preamble of Applicant's claim 1 simply states that the system is "for reducing errors in ordering". Contrary to Applicant's assertion, "for reducing errors in ordering" constitutes intended use, not a limitation. To the Examiner's recollection, the purpose of changing the preamble during the noted interview was that the original preamble language was misdirected since the intended use of the invention is during the ordering process rather than to services and billing as originally recited, which did not make sense. Nowhere in the body of the claim are there details of the actual submitting of an order. Rather, the claim simply recites "sequentially displaying a plurality of accessorial services and requiring the user to address each of said accessorial services...". Further, "reducing errors in ordering" is a broad concept. Viking Freight clearly reduces errors in ordering by having the user indicate the desired accessorial services and allowing the user to obtain rate requests.

Services vs. Rates

Applicant makes a distinction between accepting or declining a service and requesting a rate. The Examiner submits that these two are not mutually exclusive, and therefore the distinction is a false one. While it is true that the system of Viking Freight is directed toward submitting a rate request, it also clearly involves choosing or not choosing (i.e., accepting or declining) the various accessorial services, and thus reads on Applicant's claim.

Date of Viking Freight Reference

The Examiner submits that the June 8, 1998 date is a valid date. The waybackmachine service scanned the internet pages at the various search result dates provided. Accordingly, those

pages linked to those dates cannot be changed thereafter. The rate request document dated June 8, 1998 was on the Viking Freight website on both the June 11, 1998 and November 11, 1998 scan dates. Accordingly, the document was publicly available at the latest on June 11, 1998. By either date, the Viking Freight reference clearly constitutes valid prior art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Viking Freight.

In view of the response to arguments set forth above, the rejections of claims 1-3 and 6 set forth in the previous Office Action (paper #13) are hereby carried forward and maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc E. Norman whose telephone number is 703-305-2711. The examiner can normally be reached on Mon.-Fri., 8:00-5:30, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Denise Esquivel can be reached on 703-308-2597. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5648.

MN



MARC NORMAN
PRIMARY EXAMINER